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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,537	09/19/2003	Richard D. Dettinger	ROC920030157US1	4274
46797	7590	02/16/2010	EXAMINER	
IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			LY, CHEYNE D	
		ART UNIT	PAPER NUMBER	
		2168		
		MAIL DATE		DELIVERY MODE
		02/16/2010		PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD D. DETTINGER, CALE T. RATH,
and RICHARD J. STEVENS

Appeal 2009-001298¹
Application 10/664,537
Technology Center 2100

Decided: February 16, 2010

Before JAMES T. MOORE, *Vice-Chief Administrative Patent Judge*,
JEAN R. HOMERE, and DEBRA K. STEPHENS, *Administrative Patent
Judges*.

HOMERE, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Filed on September 19, 2003. The real party in interest is IBM Corp. (App. Br. 3.)

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I. STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) (2002) from the Examiner's final rejection of claims 1 through 5, and 20 through 28. Claims 6 through 19 and 29 through 38 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b) (2008).

We affirm.

Appellants' Invention

Appellants invented an interface for allowing a user to annotate a selected data object in a query result to thereby expand the scope of the annotation to encompass other data objects in the query result. (Spec. 18-20, para. [0060, 0064-0065].) As depicted in Table 1, upon receiving a query result having a plurality of data objects, the user may select to annotate a desired data object by associating therewith a model entity (e.g. a primary key) specifying a field related to the selected data object in such a way that the annotation may be viewed by other users that access any of the other data objects. (Spec. 3, para., [0008, 0010, 0021, 0055].)

Illustrative Claim

Independent claim 1 further illustrates the invention. It reads as follows:

1. A method of exchanging information via an annotation, comprising:

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providing an interface allowing a first user to view query results including one or more data objects the first user is authorized to view, select a data object from the query results, and create an annotation with a scope encompassing a selected data object; and

providing an interface element allowing the first user to expand the scope of the annotation to encompass one or more data objects the first user is not authorized to view.

Prior Art Relied Upon

The Examiner relies on the following prior art as evidence of unpatentability:

Evans	US 5,924,074	Jul. 13, 1999
Clark	US 5,974,389	Oct. 26, 1999
Palomo	US 2003/0120527 A1	Jun. 26, 2003

Rejections on Appeal

The Examiner rejects the claims on appeal as follows:

1. Claims 1 through 4 and 20 through 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Evans and Palomo.
2. Claims 5 and 25 through 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Evans, Palomo, and Clark.

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Appellants' Contentions

Appellants contend that Evans does not teach an interface that allows a user to expand the scope of an annotation to encompass one or more data objects, as recited in independent claim 1. (App. Br. 9-11.) According to Appellants, while Evans discloses progress notes or perhaps annotations that are linked to one another, such note linkage has nothing to do with expanding the scope of the annotation. (*Id.* at 10.)

Examiner's Findings

The Examiner finds that Evans' disclosure of an interface that allows a medical professional to annotate a patient's medical history (e.g. physical examination or lateral cervical data) on different dates teaches expanding an annotation encompassing one or more data objects. (Ans. 8-10.)

II. ISSUE

Have the Appellants shown that that the combination of Evans and Palomo is insufficient to describe an interface that allows a user to expand the scope of an annotation to encompass one or more data objects, as recited in independent claim 1?

III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

Evans

1. Evans discloses an interface that allows a healthcare provider to create an annotation for a selected item in a patient data. (Col. 7, ll. 6-26.)
2. As shown in Figure 8, and as acknowledged by Appellants, the disclosed interface also allows the healthcare provider to edit and add data to an annotation previously created for a data item. (Reply Br. 5.)

IV. PRINCIPLES OF LAW

Obviousness

On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness. *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

V. CLAIM GROUPING

Appellants separately argue the patentability of claims 1, 5, and 26. In accordance with 37 C.F.R. § 41.37(c)(1)(vii), we consider claims 1 through 5 and 20 through 28 as standing and falling with claims 1, 5, and 26.

VI. ANALYSIS

Independent claim 1 requires, in relevant part, an interface that allows a user to expand the scope of an annotation to encompass *one or more* data objects. As set forth in the Findings of Facts section, *supra.*, Evans discloses an interface that allows a health care professional to create an

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annotation for a data item, as well for editing the annotation by adding data thereto. (FF. 1-2.)

We find that by adding data to a previously created annotation for a selected data item, Evans teaches expanding the scope, size or content of the annotation for the selected data item. Since the disputed limitation requires that the annotation be expanded for at least a single data object, we find that Evans' disclosed expansion for the selected data item does encompass the data item.

We find untimely and unavailing Appellants' contention in the Reply Brief that the combination of Evans and Palomo does not teach expanding an annotation to encompass one or more data objects *the first user is not authorized to view*. (Reply Br. 3).² We also find unavailing and untimely Appellants' argument that there is insufficient rationale to combine Evans and Palomo. (Reply Br. 6.)³ We note that Appellants raised these arguments for the first time in the Reply Brief. We further note that these arguments are not raised in response to any new grounds of rejection the Examiner may have raised in the answer, or to address changes or developments in the law that may have occurred after the principal brief was

² “[I]t is inappropriate for appellants to discuss in their reply brief matters not raised in ... the principal brief[]. Reply briefs are to be used to reply to matter[s] raised in the brief of the appellee.” *Kaufman Company v. Lantech, Inc.*, 807 F.2d 970, 973 n.* (Fed. Cir. 1986).

³ *Id.*

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filed. Therefore, Appellants' attempt to introduce such belated arguments in reply brief is improper. We therefore will not consider these arguments.

It therefore follows that Appellants have not shown that the Examiner erred in finding that the combination of Evans and Palomo renders claim 1 unpatentable.

Regarding claims 5, 25, 27, and 28, Appellants argue that since Clark does not recite an annotation, the combination of Evans, Palomo, and Clark does not teach displaying to a second user an indication of the annotation. (App. Br. 12.) We do not agree. As discussed above, we find that Evans discloses creating and editing the annotation. Further, the appellants have not put forth sufficient argument or evidence to rebut the Examiner's finding that Clark describes allowing a second user to display the chart of a patient that a first user previously annotated. (Ans. 10, see Clark col. 9, ll. 33-45.) It follows that Appellants have not shown that the Examiner erred in concluding that the combination of Evans, Palomo, and Clark renders claims 5, 25, 27, and 28 unpatentable.

Next, Appellants argue that the Examiner did not address the additional limitations of claim 26. Therefore, they urge the rejection is deficient. (App. Br. 12.) We do not agree. The final office action indicates that the Examiner adequately considered claim 26 (Fin. Rej. 6-7), made sufficient findings, and concluded that claim 26 would have been obvious. Further, in the Answer, the Examiner repeated the rejection, and rebutted Appellants' argument. (Ans. 7, 11.) However, Appellants have not presented sufficient argument to overcome the Examiner's position. It

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follows that Appellants have not shown by sufficient argument and evidence that the Examiner's conclusion that the combination of Evans, Palomo, and Clark renders claim 26 unpatentable should be reversed.

VII. CONCLUSION OF LAW

Appellants have established that the Examiner erred in rejecting claims 1 through 5 and 20 through 28 as being unpatentable under 35 U.S.C. § 103(a).

VIII. DECISION

We affirm the Examiner's rejection of claims 1 through 5 and 20 through 28.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2009).

AFFIRMED

rwk/nhl

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